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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,519	08/10/2001	Luca Chiarabini	60004035-3	4981

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER

ZURITA, JAMES H

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 01/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/925,519

Applicant(s)

CHIARABINI ET AL.

Examiner

James H. Zurita

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10 and 27-38 is/are pending in the application.
- 4a) Of the above claim(s) 31-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Prosecution History

The following is presented to clarify the record.

On 10 August 2001, applicant filed the instant application. The application was published on 28 February 2002 as PG-PUB 20020026379.

On 15 March 2005, the Examiner issued an Election/Restriction Requirement.

On 15 April 2005, applicant elected claims 10 and 12 with traverse.

On 27 June 2005, the Examiner rejected claims 10 and 12 as anticipated by Blumberg et al. (PG-PUB 2003/0140315), filed 7 June 1999.

On 11 October 2005, applicant responded to the rejection.

Response to Amendment

On 11 October 2005, applicant amended claim 10, cancelled claims 1-9 and 11-26 and added claims 27-38.

Claims 10, 27-38 are pending, of which claims 31-38 are withdrawn, as discussed below.

Claims 10, 27-30 will be examined.

Election/Restrictions

The Examiner has carefully and thoroughly considered applicant's arguments of 27 June 2005 traversing the election restriction requirement. Applicant has also

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carefully and thoroughly considered applicant's additional arguments of 11 October 2005 concerning the requirement.

As to claims 1-26, Applicant argued that the restriction requirement is improper:

- ...examining the Application on its merits does not place the Office under a serious burden [pages 12-13].
- ... the current restriction requirement is unduly burdensome on the Applicant [pages 14-15].
- ...[election/restriction requirement] will increase the burden on the Office [page 16].

While these arguments are now moot in view of cancellation of claims 1-9 and 11-26, the Examiner will take this opportunity to elaborate on the requirement.

The Examiner respectfully disagrees and notes that applicant nowhere asserts that the various embodiments are obvious variations over another, although applicant appears to agree that the inventions are not patentably distinct.

The Examiner also respectfully disagrees with applicant's comments that such searches would not be overly burdensome. The Examiner respectfully notes that the Office requires that Examiners search claims without limiting searches to particular classes and subclasses. Thus, any search must include various types of searches, including textual searches and image searches of all classes and subclasses in each of multiple databases of US patents, PG-PUBS, foreign patents non-patent literature, the Internet and Internet archives.

As to claims 31-38, these claims remain withdrawn by original presentation as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The claims recite specific features such as:

- receiving at least one order for print products on-line, said at least one order having an item requiring a **particular ink type** (claim 31)
- within a said print service provider facility, electronically allocating said item to a printer device based on said printer device having said particular **ink type** loaded onto said printer device; (claim 31)

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- printing said item according to said order, with said printer device, and using said particular ink type. (claim 31)
- printing a print item according to said order; (claim 36)
- electronically arranging a plurality of **virtual print items** on at least one virtual media sheet (claim 36)
- **re-sorting said plurality of virtual print items amongst** said at least one virtual media sheet in a manner which minimizes a number of cuts applied to said at least one virtual media sheet (claim 36).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 31-38 remain withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The requirement is still deemed proper and is therefore made FINAL.

Response to arguments

Applicant's arguments filed 11 October 2005 have been fully considered.

Objections to the drawings are withdrawn in view of amendment.

Applicant's arguments concerning rejection under 35 USC 192(e) are not persuasive.

Applicant argues that the prior art does not disclose his new limitations

...receiving at least one order for print products on-line, said at least one order having an item requiring a particular sheet material;

...
within a said print service provider facility, electronically allocating said item to a printer device based on said printer device having said particular sheet material loaded on said printer device; and
printing said item according to said order, with said printer device, and on said particular sheet material.

In response to these arguments, the new limitations are addressed in the rejection above.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 30 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

It is not clear how allocation occurs to a printer device further based on a percentage utilization of said printer device. Percentage is a part of a whole expressed in hundredths. A device, including a printer device, is either being utilized or not.

For purposes of this examination, the claim will be interpreted as referring to a printer device that is available.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 10, 28-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Blumberg et al. (PG-PUB 2003/0140315), filed 7 June 1999.

As per claim 10, Blumberg discloses providing on-line print services:

receiving at least one order for print products on-line (See, for example, at least references to receiving print orders at vendors, as in paragraphs 6-8) said at least one order having an item requiring a particular sheet material. See references to printing materials, including paper, as in paragraphs 9, 27-30, 123.

electronically distributing said at least one order to at least one print service provider facility. See, for example, paragraph 42, which discloses routing to in-house print center or external service providers. See also paragraph 117, concerning routing a job to appropriate print service providers. See also references to distributing print orders to available printers at reproduction centers and other print facilities, as in paragraph 147. See also references to distributing print orders to local and remote production centers, as in paragraph 151.

within a said print service provider facility, electronically allocating said item to a printer device (See, for example, prioritizing and routing orders, as jobs to one or more printer devices at the centers, at paragraph 151. Please note that orders are orders for specific items. For targeting to specific devices, see at least paragraph 132, concerning targeting specific output device such as a color printer. Blumberg discloses allocating an item to a printer device based on said printer device having, said particular sheet material loaded on said printer device. See paragraph 105, 172, for printer devices that print on materials such as clay (mugs), cloth (t-shirts).

printing said item according to said order (see paragraph 116, which discloses tracking a job progress as it proceeds though the workflow. See also paragraph 117,

concerning actions that take place after a job is completed. See also references to delivery, billing and payment for ordered print products, paragraph 116) with said printer device, and on said particular sheet material. See also references to targeting specific printer devices with appropriate components such as particular software, as in paragraph 146. see also references to resource availability, as in paragraph 152.

Blumberg discloses allocating a plurality of said print items to a plurality of printer devices, taking into account for each printer device, parameters selected from the set: availability of said printer device; a sheet material type loaded onto said printer device; an ink type loaded onto said printer device; a percentage utilization of said printer device. See, for example, at least references to routing to particular printer devices based on job type and resource availability. Blumberg also discloses distributing materials to specific printers such as color printers, t-shirts, mugs.

As per claim 28, Blumberg discloses that electronically distributing is based on said at least one print service provider facility being capable of printing on said particular sheet material. For targeting to specific devices, see at least paragraph 132, concerning targeting specific output device such as a color printer. See also references to lamination, as in paragraph 9. For other types of products and their devices, see paragraph 172.

As per claim 29, Blumberg discloses electronically arranging a plurality of virtual print items on at least one virtual media sheet and re-sorting said plurality of virtual print items amongst said at least one virtual media sheet in a manner which minimizes a number of cuts applied to said at least one virtual media sheet. See for example,

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references to paragraph 96. See also references to printing eight-page booklets on a single large page, thereby minimizing the number of cuts to the virtual media sheet.

As per claim 30, Blumberg does not specifically disclose that electronically allocating allocates an item to a printer device further based on a percentage utilization of said printer device. See references to available printers, as in paragraph 147. See interpretation in light of rejection under 35 USC 112, first paragraph.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Blumberg, above, in view of Official Notice.

As per claim 27, Blumberg **does not** disclose that the particular sheet material comprises canvas. Blumberg discloses printing specialized products, such as glossy marketing and advertising materials, t-shirts, etc., as in paragraph 172. Official Notice is taken that it is old and well known to print on sheet materials such as cloth and other types of materials, including canvas. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Blumberg and general knowledge to disclose that particular sheet material is canvas. One of ordinary skill in the art at the time the invention was made would have been motivated to combine

Blumberg and general knowledge to disclose that particular sheet material is canvas for the obvious reason that marketing products such as printed canvas bags, for example, may help to promote a company's image.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Zurita whose telephone number is 571-272-6766. The examiner can normally be reached on 8a-5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James Zurita

Patent Examiner

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26 December 2005


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